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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,021	10/10/2003	Kenneth Turos	2067.030	3201
7590	07/27/2005		EXAMINER	
Ray R. Regan LAW OFFICE OF RAY R. REGAN, P.A. P.O. Box 1442 Corrales, NM 87048				ADDISU, SARA
			ART UNIT	PAPER NUMBER
			3722	
DATE MAILED: 07/27/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/684,021	TUROS, KENNETH	
Examiner	Art Unit		
Sara Addisu	3722		

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 03 May 2005.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-25 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-25 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 03 May 2005 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.  
\_\_\_\_\_

**DETAILED ACTION**

***Drawings***

The drawings were received on 5/3/05. These drawings are acceptable. The objection to the drawing is withdrawn.

***Specification***

The correction to the Specification was received on 5/3/05. The objection to the Specification is withdrawn.

***Claim Rejections - 35 USC § 112***

The rejection of the claims under 35 USC 112 1<sup>st</sup> and 2<sup>nd</sup> paragraph is withdrawn due to Applicant's remarks, pages 12- 13.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

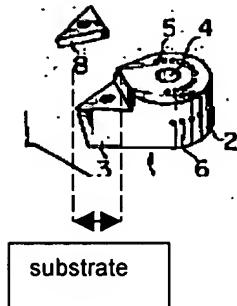
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-13 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki (U.S. Patent No. 4,057,884).

Suzuki teaches a tool having an elongated shank (arm) (11) (which gets held/clamped by a tool carriage "keeper", Col. 2, lines 66-68), a tool bit supporting member (swivel member) (1) with series of indexing recesses (5) spaced from each

other at an angle of 15 degrees over a range of 180 degrees (i.e. capable of adjustably positioning the swivel member at an acute angle, between 0 and 35 degrees, to the longitudinal axis), a coupler for removably connecting the arm to the swivel member and locking means to position the removable tool bit (8) that is located on the leading end of swivel member (see Figure 1 and Col. 2, lines 30-32). Suzuki also teaches one end of the elongated shank (arm) (11) having spaced limbs with opposing bores (a plurality of monolithically formed bar extensions) (12 & 13) to create a recess (slot) (15) to rotatably receive body portion (monolithically formed tongue) (2) formed at one end (i.e. trailing end) of the swivel member (1). [Merriam-Webster Online Dictionary defines monolithic as: cast as a single piece/ consisting of or constituting a single unit]. Furthermore, Suzuki teaches the body portion (tongue) (2) having a bore (4) {which is substantially equivalent to the opposing bores of bar extensions 12 & 13}, and a generally cylindrical shape (i.e. the curved portion constituting partially beveled) accompanied with series of indexing recesses (6) for restricting movement of the swivel member (1). Additionally, Suzuki teaches a tool (key) (27) and locking means that include tightening bolt (connector) (16) that extends between bore (4) of the swivel member (1) and the opposing bores of limbs (12 & 13) (See Figures 1 & 2). Suzuki also teaches a swivel member having a substrate to which the tool bit (8) is removable mounted (see diagram below). Figures 1, 3 and 4 show the substrate and the tool bit having variable dimensions (e.g. triangular, circular and diamond shaped).



***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (U.S. Patent No. 4,057,884).

Suzuki teaches a tool with an arm, swivel member having a cutter as set forth in the above rejection. Suzuki also teaches a swivel member having a substrate to which the tool bit (8) is removable mounted, as set forth in the above 102 (b) rejection.

Regarding claim 14, Suzuki discloses the claimed invention except for the hole of the swivel member (the tongue) being threaded. It would have been obvious to one having ordinary skill in the art at the time the invention was made to threads the through hole of the tongue such that it receives a bolt (connector) with more threads for the purpose of having stronger engagement between the two parts such that the swivel member would be held in place firmly and won't get loose during vibration thus giving a better finish on

the workpiece, since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art (i.e. duplicating the threading of the upper limb (13) to engage with the threaded part of the bolt).

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (U.S. Patent No. 4,057,884).

Suzuki discloses the claimed invention except for, the swivel member formed a slot between two extensions and the arm formed a tongue. It would have been obvious to one having ordinary skill in the art at the time of the invention was made reverse the location of the two extensions (having a bore) with the tongue (having a hole), since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. ~~In re Einstein, 8 USPQ 167.~~ 7/25/05  
B

Applicant should further note that Specification gives no criticality to the claimed limitation (see Page 6, lines 19-25).

Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (U.S. Patent No. 4,057,884) in view of Turos (U.S. Patent No. 6,279,919).

Suzuki teaches a tool with an arm, swivel member having a cutter as set forth in the above rejection.

However, Suzuki fails to teach workpiece on a rotatable shaft (brake lathe adapter system).

Turos teaches the use of a brake lathe adapter system to secure a brake rotor to a rotatable shaft of a lathe (Col. 1, lines 17-20). Turos also teaches the use of cutting tool to refinish or resurface the secured brake rotor (Col. 2, lines 22-28).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to adapt Suzuki's invention to the brake lathe system as taught by Turos' for the purpose of machining a workpiece (e.g. brake rotor) ('919, Col. 1, lines 22-24).

Claims 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (U.S. Patent No. 4,057,884) in view of Turos (U.S. Patent No. 6,279,919), and further in view of Gifford et al. (U.S. Patent No. 1,435,288).

Suzuki teaches a tool with an arm, swivel member having a cutter as set forth in the above rejection. Suzuki also teaches threads within at least one of the hollow bores of the arm (i.e. bar extension 13).

Turos teaches the use of a brake lathe adapter system to secure a brake rotor to a rotatable shaft of a lathe as set forth in the above rejection.

However, the modified device of Suzuki fail to teach the arm of the tool having a hexagonal cross section.

Gifford et al. teaches a tool having a rod/handle (11) having a hexagonal shape (See Figure 1& 2 and Page 2, left col., line 28).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Suzuki's invention such that the arm has a

hexagonal cross-section as taught by Gifford et al. for the purpose of providing ease of grip/handling.

***Response to Arguments***

Please note that On Page 21, line 14, Applicant states "two declarations" have been submitted. Only one declaration, by David Norgen, has been received

The Declaration under 37 CFR 1.132 filed 5/3/05 is insufficient to overcome the rejection of claims 1-25 based upon 35 U.S.C. 103(a) and 35 U.S.C. 102, as set forth in the last Office action because:

It states that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04.

Exhibit A and Exhibit B submitted mention the "shaping tool" of the instant application receiving an award by Undercar Digest in 2003 for being Top 10 Tools. The Exhibits do not give details of what type of tools and the number of tools that entered the contest, what the criteria was for objectively judging the functionality of the tools to be nominated Top 10 etc.

Applicant's arguments filed 5/3/05 have been fully considered but they are not persuasive.

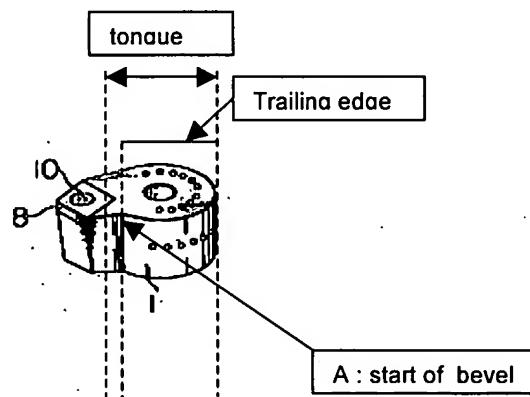
Regarding claims 1, in response to Applicant's assertion on page 14, lines 24-27, that "the term "coupler" is defined by applicant as including ... a tongue formed in one end of the swivel member that is removably and rotatably mountable in the slot formed between the two bar extensions of the arm", it is noted that although the claims are interpreted in light of the specification, the limitation of the term "coupler" are not read in claim 1. As the Applicant pointed out on page 14, line 27 of the Remark, the limitation of the term "coupler" is introduced in dependent claims 2-3. Suzuki (U.S. Patent No. 4,057,884) teaches one end of the elongated shank (arm) (11) having spaced limbs with opposing bores (a plurality of monolithically formed bar extensions) (12 & 13) to create a recess (slot) (15) to rotatably receive body portion (monolithically formed tongue) (2) formed at one end (i.e. trailing end) of the swivel member (1).

Applicant's arguments with respect to claims 14-17 have been considered but are moot in view of the new ground(s) of rejection (due to the fact that the rejection of the claim 14-17 under 35 USC 112 1<sup>st</sup> paragraph is withdrawn). See rejection above.

In response to Applicant's assertion on page 14, lines 28-29, that "Suzuki Patent does not disclose a hole formed in one end of the tongue", Applicant is referred to Suzuki, '884, Figure 1, which shows tongue (2) having a hole (4).

In response to Applicant's assertion on page 14, line 33- page 15, line 6 that Suzuki Patent does not disclose a partially beveled edge formed in the trailing edge of

the tongue for restricting movement of the swivel member, Applicant is referred to the diagram below where the trailing edge of the tongue is indicated. It should be noted that Suzuki teaches a partially beveled edge (starting at A) formed in the trailing edge for restricting movement of the swivel member by engaging ball (26) with one of the recesses (6) located in the beveled section of the trailing edge ('884, Col. 2, lines 49-55). With regards to the "means for locking" recited in claims 1 and 19, the limitation meets the three-prong test per MPEP 2181 and thereby invokes 35 U.S.C. 112, 6<sup>th</sup> paragraph. Suzuki teaches ball (26) being engaged with one of the recesses (6). Ball (26) and recess (6) are capable of performing the identical function "positioning the cutter in relationship to a surface of the workpiece" in substantially the same way (swinging swivel member to a desired position) and produces substantially the same result (indexing cutter/positioning cutter in relation to a workpiece) as a bevel.



In response to Applicant's assertion on page 15, lines 16-17 that the "adjustably positioning of the swivel member" is not anticipated by Suzuki's teaching of the series of indexing recesses, the term "adjustably position the swivel member at an acute angle to the longitudinal axis through the arm", when read broadly is anticipated by Suzuki since the purpose of the series of indexing recesses is to adjustably position the swivel member.

In response to Applicant's assertion on page 16, lines 27-28 that "Examiner's mere reversal argument seems to suggest that Applicant is not entitled to claims to more than one embodiment", it is respectfully submitted that the Examiner is not arguing the Applicant's entitlement to more than one embodiment but emphasizing the modification (reversal of parts) being obvious. Applicant's argument addresses "entitlement of more than one embodiments" and does not address the rejection of reversal of parts therefore is not germane to the rejection.

Regarding Applicant's statement on page 18, lines 24-26, that the "as set forth in the above rejection" statement to mean the rejection of claim 18, it is respectfully submitted that the "as set forth in the above rejection" mentioned on page 7, the last two sentences of Office Action mailed 3/10/05 is referring back to the 102(b) rejection and not to claim 18.

In response to Applicant's assertion on page 20, line 32 that "nothing stated in the Gifford Patent provides any reason for the hexagonal shape", Examiner respectfully submits that it is obvious to one of ordinary skill in the art at the time of the invention was made to utilize hexagonal shape since it gives a better grip due to friction.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Addisu at (571) 272-6082. The examiner can normally be reached on 8:30 am - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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*B - A*  
BOYER D. ASHLEY  
PRIMARY EXAMINER